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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,630	10/29/2001	Philip C. Wong	JHU1690-2	6218

7590

01/07/2005

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EXAMINER

BERTOGLIO, VALARIE E

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/003,630

Applicant(s)

WONG ET AL.

Examiner

Valarie Bertoglio

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12/15/2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 34, 40 and 58.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 04/09/03

10. ☐ Other: _____

Joe Wontack
AU 1632

Continuation of 2. NOTE: The proposed amendment to claim 34 would change the breadth of the transgenic mouse overexpressing Abeta1-42. The pending claims are rejected under 35 USC 112, 1st paragraph as lacking enablement because the pending claims read on a transgenic mouse overexpressing a transgene encoding Abeta1-42, which has been shown in the art to not produce the desired effect of increased levels of secreted Abeta1-42 and plaque formation, see page 9, paragraph 2 of the non-final office action mailed 10/03/03. Staufenbiel (2001) taught that secreted Abeta1-42 is hardly detectable in these mice. The proposed claims read on any transgenic animal comprising any transgene that results in overexpression of Abeta1-42, not necessarily encoding Abeta1-42. Applicant has provided art demonstrating that there are mice, Tg2576 mice, that carry a mutant APP gene that results in increased secretion of several Abeta isoforms, including Abeta1-42, leading to the desired effect of increased Abeta1-42 secretion accompanied by behavioral deficits. These mice are structurally different than a mouse comprising an Abeta1-42-encoding transgene. While entry of the proposed claim amendment may overcome the enablement issues of record, it would also require additional search and considerations to determine whether it necessitates any new grounds of rejection, including scope of enablement, written description, and novelty or obviousness. Therefore, the proposed amendments are not entered but would be considered upon entry of an RCE. The use of the term "similar" also necessitates a new grounds of rejection as the term is indefinite (see MPEP 2173.05(b)).

Continuation of 3. Applicant's reply has overcome the following rejection(s): Applicant's reply has not overcome any of the rejections as the amendment has not been entered..